Detailed Office Action

Status of Claims

1. Claims 1-10 have been examined.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5 and 7-10 are rejected under 35 U.S.C. 102(e) by U.S. Patent No. 5,465,206 to (Hilt) Hilt et. al.

In Reference to Claim 1

A method for preparing a payment transaction using a communication terminal associated with a payer (consumer C) and a receiver terminal associated with a payee (biller B), where the communication terminal is associated with a first payment system (Fig. 4, col. 12 lines 47-55, discloses Bank C as payment system, col. 13 lines 17-21), in a first communication network and the receiver terminal is associated with a second payment system (Fig. 4, col. 12 lines 47-55, discloses Bank B as payment system, col. 13 lines 17-21), comprising:

prompting, via a payment request message relating to the payer from the receiver terminal (col. 13 lines 17-21, discloses materials passes between participants including a payment message and bill pay order), the second payment system to create authorization data (Background, col. 3 lines 53-57, discloses second common element to bill pay transaction relating to the biller is payment authorization) associated with the payment request message and sending them to the receiver terminal (col. 3, discloses payment message 124 passes from Bank C to Bank B through payment network 102, Fig.4); transmitting, via the receiver terminal, a further payment request message together with the authorization data to the first payment system (col. 13 lines 52-55, discloses a transaction between C and B with account number, funds, and authorization to pay the amount to the biller with BRN (biller reference number) Fig. 4); checking with use of the authorization data (Background, col. 3 lines 53-57, discloses the consumer performs some act (e.g., signs a check or other instrument) which authorizes the consumer's bank to transfer funds from the consumer's account to the biller); via the first payment system, whether the payee is authorized to participate in the payment transaction (col. 10 lines 37-41, discusses a bill pay system in which participating consumers pay bills to billers where billers are identified); and transmitting, when authorized, via the first payment system, a guarantee data record guaranteeing payment by the payer to the receiver terminal (col. 14 lines 32-37, discloses account information of

consumer in the and the implicit guarantee of consumers bank to provide good funds to cover payment).

In Reference to Claim 2

The method as claimed in claim 1, wherein the second payment system uses the payment request message to ascertain the first payment system, which is configured for use by the payment transaction and sends identification data (col. 14 lines 32-37,discloses A/R (accounts receivable) data passed from Bank B to biller , BRN and includes the payment amounts and C and B accounts of messages received) for the first payment system together with the authorization data to the receiver terminal (col. 13 lines 50-55, discloses a bill pay order 122, shown passing from consumer C to Bank C, order 122 contains B's BRN, C's C-B account number, an amount, a desired transaction date, the source of funds, and authorization to pay the stated amount to the biller with that BRN, Fig. 4), and the receiver terminal uses the identification data to transmit the further payment request message and the authorization data to the first payment system (col. 13 lines 41-46, discloses Biller B's BRN appears on bill 120 sent from B to C; bill 120 includes an indication that biller B will and can accept electronic payments through this system, also B's BRN, an amount due, possibly a due date, and C's C-B account number, line 54-55 disclosing authorization to the biller).

In Reference to Claim 3

The method as claimed in claim 1, wherein the further payment request message prompts the first payment system to output a data message prompting clearing of cash resources between the payer and a first payment service provider (Bank C) for the first payment system (Fig. 11, Bank C, col. 21 lines 1-5 discloses, consumer sends a bill payment order to the consumer's bank (Bank C). The order instructs Bank C to debit C's account with Bank C on the date indicated in the order by the amount indicated in the order and forward the funds to the payment network with the BRN and C-B account number indicated in the order).

In Reference to Claim 4

The method as claimed in claim 1, wherein the receiver terminal transmits the guarantee data record to the second payment system and then the second payment system outputs a further data message (Fig. 4, A/R 40, col.14 lines 50-55, discloses an A/R data file being passed from Bank B to biller B in an agreed-upon format with an agreed-upon timing, indicating which payment messages with a specified data format were received by Bank B) prompting clearing of cash resources between the payee and a second payment service provider (Fig. 11, Bank B, col. 21 lines 57-61, discloses at block 266, the payment network debits Bank C in the amount of the payment message, and credits Bank B (the biller's bank) by the same amount.) for the second payment system.

In Reference to Claim 5

The method as claimed in claim 1, wherein one of the payment systems outputs a third data message prompting clearing of cash resources between the first payment service provider for the first payment system and the second payment service provider for the second payment system (Fig. 11, col. 21 lines 59-61, discloses at block 268, Bank B credits the biller's account, who in turn, at block 270, credits the consumer's account with the biller).

In Reference to Claim 7

The method as claimed in claim 1, wherein information relating to a payment sum, which is to be paid to the payee by the payer, is transmitted to the receiver terminal with the guarantee data record (Fig. 4, col. 14 lines 32-37, discloses message 124 includes a BID (bank identification) identifying Bank C, a BID identifying Bank B, a BRN identifying biller B, a C-B account number identifying consumer C (payer) with biller B (payee), an amount, and the implicit guarantee of Bank C to provide good funds to cover payment in the amount indicated by the message.)

In Reference to Claim 8

The method as claimed in claim 7, wherein the first payment system precedes transmission of the guarantee data record to the receiver terminal by performing a difference formation in which the payment sum is reduced by an

amount, which is incurred for use of the first payment system record (col. 11 lines 9-22, discloses a bank C (first payment) debits the account designated by consumer C as the source of funds for that payment and is obligated to a net position with the payment network; likewise, bank B receives a net position from the payment network and credits biller B's bank account. Bank B's net position is equal and opposite to Bank C's net position except for a small processing fee, which is collected by the payment network from the transfer to finance the costs of operating the payment network.).

In Reference to Claim 9

The method as claimed in claim 4, wherein the first payment system and the second payment system are used to prepare a payment transaction across payment systems (Fig. 6, col. 16 lines 4-9 discloses in Fig. 6 is a more detailed block diagram of payment network 102 and its environs, which shows how payment message 124 passes from Bank C through clearing subsystem 106 to Bank B. Clearing subsystem 106 is used to log and transfer payment messages 124 from consumer banks to biller banks.).

In Reference to Claim 10

The method as claimed in claim 1, wherein the second payment system is associated with a second communication network, and the first payment system and the second payment system are used to prepare a payment transaction across communication networks (Fig. 4, col. 10 lines 44-54 and lines 63-67

discloses a bill payment system including the consumer and biller participants. Consumers receive bills from participating billers (paper/mail bills, e-mail notices, implied bills for automatic debts, etc.) which indicate an amount, and a unique biller reference number ("BRN") identifying the biller to the payment network. When Bank C receives the bill payment order from consumer C, Bank C then submits an electronic transaction, a payment message, into a payment network directed to Bank B (biller's bank), which is determined from the BRN of the transaction.)

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claim 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Hilt in view of U.S. Pub. No. 2003/0028484 to (Boylan) Boylan et al.

In Reference to Claim 6

Hilt discloses the method as claimed in claim 1, above. However, Hilt does not explicitly teach authorization data appertaining to a digital signature. Boylan teaches:

A digital signature is transmitted to the receiver terminal as authorization data (0061, discloses checking the validity of a digital signature for authenticity of payee and 0063, discloses encryption or signature to enhance the security of payment).

It would have been obvious to one having ordinary skill in the art at the time of invention to modify the system of payment transactions of Hilt to include digital authorization data of Boylan to enhance the security of electronic payment procedure in communication terminals.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Pub No. 2002/007322, Wisecarver,III et al. discusses a transaction system, where consumers pay bills to participating billers through a payment network without any requiring credit or sensitive information.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mauricio E. Williams whose telephone number is (571) 270-5051. The examiner can normally be reached on M-F 8:30 a.m. to 5:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kenneth Bomberg can be reached on (571) 272-4922. The fax phone number for the organization where this application or proceeding is assigned is 571-

273-8300.Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see **http://pair-direct.uspto.gov.** Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Patent Examiner

/Kenneth Bomberg/

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